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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/705,252	11/02/2000	Robert D. Covington	635482.625.014	4471

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EXAMINER

POND, ROBERT M

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 03/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/705,252

Applicant(s)

COVINGTON ET AL.

Examiner

Robert M. Pond

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8 and 9</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1, 3, 6-12, 14-17, 19, 21-23, 25-38, and 41-46 are rejected under 35 USC 103(a) as being unpatentable over LeRoy (patent number 5,970,474), in view of Robertson (patent number 6,609,106).**

LeRoy discloses a system and method of shopping in a physical retail location and online, creating a wish list by a registrant who may either scan product selections while physically in a store or create the wish list online (e.g. from home), and customers making actual purchases on behalf of the registrant based on the registered wish list (see at least abstract; col. 1, line 13 through col. 2, line 10). LeRoy further discloses:

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- Database coupled to a computer server; Providing a database and a handheld data entry unit: (see at least Fig. 1 (15, 30); col. 3, lines 23-34; col. 4, line 62; col. 7, lines 35-57).
- Handheld unit with internal memory to scan physical items; Storing item information (in handheld unit memory): (see at least col. 6, lines 2-19).
- Downloading item information to the database: (see at least col. 2, lines 19-22; col. 7, lines 42-44).
- Creating a wish list of items; storing wish list in database: registrant selects desired items (see at least col. 2, lines 19-22; col. 7, lines 42-44).
- Providing a web site to generate one or more buy lists; basing buy lists on events: registrant uses a web site to create one or more wish lists (please note examiner's interpretation: the registrant creates one or more lists of desired items to be purchased by others (e.g. wedding, birthday). The mere act of exposing the wish list to others via the gift registry system converts the wish list into a buy list from the perspective of others viewing the information who want to use the list to buy one or more items for the registrant) (see at least col. 1, lines 14-17; col. 6, lines 27-33).
- Consumer purchasing gifts for others: (please note the examiner's interpretation: a consumer purchasing gifts for others using a buy list created by another is performing a service) (see at least col. 1, lines 13-16).

- Password protection: registrant login requiring username and password (see at least col. 9, lines 53-61).

LeRoy teaches all the above as noted under the 103(a) rejection and teaches a) a registrant creating and storing a wish list in an online gift registry, b) buyers purchasing items online on behalf of a registrant from a list stored in the online gift registry, and c) extensive use of communication and computer technology to help a registrant create a buy list for buyers to use on behalf of the registrant, but does not specifically disclose what form of communications attracted these buyers to the online gift registry. Robertson teaches an online gift registry and notification method to registrants and buyers, registrants creating wish lists and buyer distribution lists used to route email messages to the registrant's buyers, and distribution based on events (see at least abstract; Fig. 1, 40, 50, 60, 70); Fig. 20a-c; Fig. 25 (400); Fig. 27 (475); col. 22, lines 14-19). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of LeRoy to include transmitting a message to a buyer listed in a distribution list based on an event as taught by Robertson, in order for a buyer to be made aware that buy lists exists for events, and thereby attract buyers to the online gift registry service.

Linking buyer to electronic retailer

LeRoy teaches all the above as noted under the 103(a) rejection but does not disclose linking the buyer to the electronic retailer that sells items on the buy list. Robertson teaches electronically linking the buyer to the electronic retailer that

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sells the item(s) on the buy list. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of LeRoy to implement electronic linking as taught by Robertson, in order to facilitate shopping convenience for the buyer, and thereby attract registrants and buyers to the service.

- 3. Claim 2 is rejected under 35 USC 103(a) as being unpatentable over LeRoy (patent number 5,970,474) and Robertson (patent number 6,609,106).**

LeRoy and Robertson teach all the above as noted under the 103(a) rejection and teach a) a registrant adding or deleting a distribution list, and b) the distribution list mechanism sending email notifications to buyers present in the registrant's distribution list. It would have been obvious to one of ordinary skill in the art at time of the invention to disclose buyers receiving authorization from the registrant to use the list, since it is well within the skill to ascertain that the registrant actively created the list of buyers.

- 4. Claims 4-5, 18, and 24 are rejected under 35 USC 103(a) as being unpatentable over LeRoy (patent number 5,970,474) and Robertson (patent number 6,609,106), as applied to Claims 1, 3, 12, 22, further in view of Official Notice (regarding access control lists).**

LeRoy and Robertson teach all the above as noted under the 103(a) rejection and teach a) users of the service logging in using a username and password, b)

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a registrant creating a distribution list of buyers to be notified of the existence of one or more buy lists, c) buyers being notified of the buy lists and performing a service on behalf of a registrant, d) public and private access to the gift registry, and e) marking or not marking items as private (Robertson: see at least col. 5, lines 34-38), but do not disclose an access control list. This examiner takes the position that it is old and well known in the computer arts that access control lists are used to restrict access to computing resources and online information as determined by the creator of the access control list and are further used to assign access to information for groups of users, each group having same or different access privileges. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of LeRoy and Robertson to implement an access control list to restrict access to online information to buyers as taught by Official Notice, in order to provide registrants with additional old and well-known control features to distribute buy lists to selected buyers, and thereby attract registrants to the service.

- 5. Claim 13 is rejected under 35 USC 103(a) as being unpatentable over LeRoy (patent number 5,970,474) and Robertson (patent number 6,609,106), as applied to Claim 12, further in view of Kraemer (patent number 6,490,602).**

LeRoy and Robertson teach all the above as noted under the 103(a) rejection and teach a handheld device used to collect product information for a gift

registry, but do not disclose a personal digital assistant. Kraemer teaches a system and method of creating a gift registry and further teach a personal digital assistant as a computing device for users (see at least col. 1, line 8 through col. 2, line 20; col. 2, lines 44-48). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of LeRoy and Robertson to use and support a personal digital assistant as a computing device as taught by Kraemer, in order to support users owning a personal digital assistant computing device, and thereby attract these users to the service.

- 6. Claim 20 is rejected under 35 USC 103(a) as being unpatentable over LeRoy (patent number 5,970,474) and Robertson (patent number 6,609,106), as applied to Claim 12.**

LeRoy and Robertson teach all the above as noted under the 103(a) rejection and teach a registrant authorizing a buyer to use the registrant's buy list, and the buyer shopping for registrant items other than what is one the buy list using a search feature, but do not disclose the buyer authorizing a second buyer to user the buy list. It would have been obvious to one of ordinary skill in the art at time of the invention to chain the authorization process, since it is well within the skill to ascertain that since a registrant is authorizing a buyer on his/her behalf, the buyer would likewise value the option to authorize a buyer on his/her behalf.

- 7. Claim 39-40 is rejected under 35 USC 103(a) as being unpatentable over LeRoy (patent number 5,970,474) and Robertson (patent number 6,609,106), as applied to Claim 38.**

LeRoy and Robertson teach all the above as noted under the 103(a) rejection and teach customers buying from a buy list on behalf of a registrant, and buyers being place on a distribution list, and shipping purchased products, but do not disclose a concierge service delivering the items on one or more buy list. It would have been obvious to one of ordinary skill in the art at time of the invention to have the concierge service deliver the items from a buy list, since it is well within the skill to ascertain that a concierge service deliver items to their customers as a consequence of performing concierge duties.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mr. Robert M. Pond** whose telephone number is 703-605-4253. The examiner can normally be reached Monday-Friday, 8:30AM-5:30PM Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Mr. Vincent Millin** can be reached on 703-308-1065.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **703-308-1113**.

Any response to this action should be mailed to:

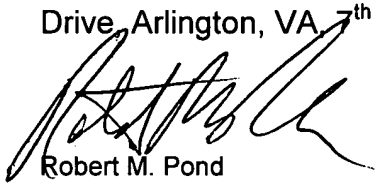
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Washington D.C. 20231

or faxed to:

703-872-9306 (Official communications; including After Final communications labeled "Box AF")

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.



Robert M. Pond
Patent Examiner
February 23, 2004